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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,404	12/15/2003	William Sobonya	MAEE 2 00035	6236
27885	7590	07/31/2006	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,404

Applicant(s)

SOBONYA, WILLIAM

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 3, 2006, has been entered.

2. The Examiner has carefully considered Applicant's amendment and accompanying remarks filed May 3, 2006. All rejections have been overcome. However, after an updated search, additional prior art has been found which renders the invention as currently claimed unpatentable for reasons herein below.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

4. The declaration under 37 CFR 1.132 filed May 3, 2006, is insufficient to overcome the rejection of claims 1-17 as set forth in the last Office action because: It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Furthermore, gross sales do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F. 2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). See MPEP § 716.03

Applicant further discusses that "no extensive advertising was conducted" on the liners of the present invention. It is unclear what is meant by "extensive."

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said scrim" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. Claims 1, 2, 3, 10, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fagan (US 4,783,354) in view of GB 1541311 (GB '311). Fagan disclose a sheet material suitable for use as shelving paper (abstract). The sheet material adheres firmly to a surface, yet can be readily removed therefrom or repositioned without marring or damaging the surface.

Additionally, the adherable, yet releasable and removable nature of the sheet material is maintained over time (col 3, ln 21-30). The invention can include a laminate comprising a top sheet of vinyl film laminated with adhesive to a polyester, non-woven backing, wherein the front side of the base sheet may be embossed (col 7, ln 18-26). Fagan discloses that the vinyl film can have a thickness of 4 mils (col 9, ln 4). Fagan discloses the claimed invention except for the teaching that a clear polypropylene protective layer is adhered to the vinyl film.

GB '311 discloses laminates for covering substrates for decorative and/or protective purposes such as shelving covers (pg 1, ln 14-15 and 30-31). The laminate is easily positioned and adhered to the substrate, and which can be removed and repositioned (pg 2, ln 19-23). A facing layer is included in the laminate and can generally be a sheet material which can be decorative or protective. Materials for the facing layer include polypropylene. The facing layer may have a decorate pattern embossed thereon (pg 4, ln 45-62). The polypropylene top layer can be substantially transparent and can be used to protect a lower sheet made of polyvinyl chloride (pg 4, ln 63-74). It would have been obvious to one having ordinary skill in the art to use the transparent and embossed polypropylene protective sheet of GB '311 on the laminate of Fagan, motivated by the desire to create a laminate that has the desired aesthetics and the protective feature provided by the polypropylene sheet.

Regarding claim 3, it should be noted that optimizing the thickness of the vinyl film is a result effective variable. The thickness of the film directly affects the durability of the entire laminate. Therefore, it would have been obvious to one having ordinary skill in the art to have made the thickness of the vinyl film be 8 mils, since it has been held that discovering an optimum

value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the film thickness motivated by the desire to create a laminate having increased durability.

8. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fagan (US 4,783,354) and GB 1541311 (GB '311) as applied to claim 1 above, and further in view of Owen (US 5,874,371). Fagan and GB '311 disclose that the backing may be a polyester nonwoven, but fails to disclose the teaching that the backing is a woven or non-woven plastic scrim and that the backing is coated with a polyvinyl chloride resin.

Owen (US 5,874,371) discloses a non-skid covering for use on a surface (abstract). The scrim comprises a PVC coated non-woven scrim (claims 2, 3, 5, and 6). It would have been obvious to have used Owen's PVC coated woven or non-woven plastic scrim as the backing material in the laminate of Fagan and GB '311, motivated by the desire to create a laminate that is lightweight and has strength, durability, and non-slip properties.

9. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fagan (US 4,783,354) in view of GB 1541311 (GB '311) and Schottenfeld (US 2002/0094404). Fagan disclose a sheet material suitable for use as shelving paper (abstract). The sheet material adheres firmly to a surface, yet can be readily removed therefrom or repositioned without marring or damaging the surface. Additionally, the adherable, yet releasable and removable nature of the sheet material is maintained over time (col 3, ln 21-30). The invention can include a laminate comprising a top sheet of vinyl film laminated with adhesive to a polyester, non-woven backing, wherein the front side of the base sheet may be embossed (col 7, ln 18-26). Fagan discloses the

claimed invention except for the teaching that a clear polypropylene protective layer is adhered to the vinyl film and that there is a protective removable covering on the laminate.

GB '311 discloses laminates for covering substrates for decorative and/or protective purposes such as shelving covers (pg 1, ln 14-15 and 30-31). The laminate is easily positioned and adhered to the substrate, and which can be removed and repositioned (pg 2, ln 19-23). A facing layer is included in the laminate and can generally be a sheet material which can be decorative or protective. Materials for the facing layer include polypropylene. The facing layer may have a decorative pattern embossed thereon (pg 4, ln 45-62). The polypropylene top layer can be substantially transparent and can be used to protect a lower sheet made of polyvinyl chloride (pg 4, ln 63-74). It would have been obvious to one having ordinary skill in the art to use the transparent and embossed polypropylene protective sheet of GB '311 on the laminate of Fagan, motivated by the desire to create a laminate that has the desired aesthetics and the protective feature provided by the polypropylene sheet.

Schottenfeld (US 2002/0094404) discloses a liner for covering a generally smooth surface comprising a PVC sheet [0019] and a PVC coated scrim [0020]. A release layer is added to the liner [0024]. It would have been obvious to one having ordinary skill in the art to have used the release layer of Schottenfeld in the laminate of Fagan and GB '311, motivated by the desire to create a laminate that has ease of shipping and improved handling characteristics.

Regarding claim 14, it should be noted that optimizing the thickness of the vinyl film is a result effective variable. The thickness of the film directly affects the durability of the entire laminate. Therefore, it would have been obvious to one having ordinary skill in the art to have

made the thickness of the vinyl film be 8 mils, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the film thickness motivated by the desire to create a laminate having increased durability.

Response to Arguments

10. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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UCR

Ula Ruddock
Ula C. Ruddock
Primary Examiner
Tech Center 1700